

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : BARTHOLOMAUS et al.
Serial No. : 10/596,202 (U.S. Patent Application Publication 2008-0286342)
Filing Date : 2 June 2006
For : FORMS OF ADMINISTRATION BASED ON CROSSLINKED
HYDROPHILIC POLYMERS
Examiner : SULLIVAN, Danielle
Art Unit : 1616

745 Fifth Avenue,
New York, NY 10151

Filed via EFS-Web
5 January 2012

**PATENT TERM ADJUSTMENT PETITION
AND STATEMENT UNDER 37 C.F.R. § 1.705(b)**

Mail Stop: Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.705, applicants herein submit a request for reconsideration of the patent term adjustment of five hundred fifteen (515) days indicated in the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) which was part of the Notice of Allowance mailed on 6 October 2011 for the above-referenced application.

STATEMENT UNDER 37 C.F.R. § 1.705(b)

I. Payment of fee (37 C.F.R. § 1.705(b)(1))

An electronic payment of \$200.00 will be made concurrently with this filing to address the fee under 37 C.F.R. § 1.18(e) for this request for reconsideration of patent term adjustment as required by 37 C.F.R. § 1.705(b)(1). Please charge any additional fee or credit any overpayment to Deposit Account No. 50-0320.

II. Correction to patent term adjustment sought by applicants (37 C.F.R. § 1.705(b)(2)(i))

Applicants respectfully request a grant of a minimum patent term adjustment of **1041** **days**.

III. The factual basis for the adjustment sought (37 C.F.R. § 1.705(b)(2)(ii))

A. Applicant Delay Pursuant to 37 C.F.R. § 1.704

Pursuant to 37 C.F.R. § 1.704 the period of adjustment of the term of the patent due to examination delay is reduced by the period of Applicant Delay. The PTO has calculated a period of Applicant Delay of **263 days**. This calculation is confirmed to be correct (see also section V. below).

B. Examination Delays Pursuant to 37 C.F.R. §§ 1.703(a)-(e)

Pursuant to 37 C.F.R. § 1.703(f), the period of adjustment of the term of the patent under § 1.702 is the sum of the periods of examination delay calculated under subparagraphs (a)-(e), to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704 (the period of Applicant Delay). In the present application, Applicants are entitled to a period of examination delay equal to the sum of the periods of delay under § 1.703(a) and (b) for the reasons set forth below.

(i) 14 Month Delay Pursuant to § 1.703(a)(1)

In accordance with 37 C.F.R. § 1.703(a)(1), applicants are entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 not later than 14 months (12 August 2007) after the actual filing date (12 June 2006 - date 371 requirements were completed).

The PTO failed to mail an Office Action under 35 U.S.C. § 132 until 3 February 2009. As such, applicants are entitled to a period of patent term adjustment beginning **12 August 2007** and ending on **3 February 2009**, the date of mailing of the Office Action. Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is **541 days**.

(ii) “Four Month Delay” Pursuant to § 1.703(a)(2)-(4)

In accordance with 37 CFR §1.703(a)(2), applicants are entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. § 132 no later than four months after a reply in compliance with:

37 C.F.R. § 111 – see 37 C.F.R. § 1.703(a)(2),

37 C.F.R. § 113(c) – see 37 C.F.R. § 1.703(a)(3); or

37 C.F.R. § 41.37 – see 37 C.F.R. § 1.703(a)(4)

was filed by the applicants (hereinafter “the Four Month Delay”).

In particular, applicants are entitled to a patent term adjustment beginning on the day after the date that is four months after the Response after Non-Final Action was filed on 23 November 2009, i.e. **23 March 2010**, and ending on the date the Final Rejection was mailed on **15 November 2010**.

Accordingly, the period of patent term adjustment due to the Four Month Delay by the Office is **237 days**, which is in agreement with the period calculated by the Office on the Patent Term Adjustment History.

(iii) Four Month Delay Pursuant to § 1.703(a)(5) – response to final decision by BPAI

Not applicable. (**0 days**)

(iv) Three Years Delay Pursuant to 37 C.F.R. § 1.703(b)

Pursuant to 37 C.F.R. § 1.702(b), Applicants are entitled to a period of delay due to the failure of the Office to issue a patent within three years (**12 June 2009**) after the date upon which the 371 requirements were completed, i.e. **12 June 2006**.

Applicants note that the Office failed to comply with this requirement, and therefore, applicants have calculated a maximum Three Year Delay of **763 days** (= 937 days - 174 days) based on the period of time beginning on the date three years after the application was filed, i.e.

12 June 2009 and the date the issue fee was paid **5 January 2011** (937 days) minus the time period from the filing of the Notice of Appeal (**15 April 2011**), and the mailing of the Notice of Allowance (**6 October 2011**) (174 days) – see 37 C.F.R. 1.703(b)(4).

(v) Delay Pursuant to 37 C.F.R. § 1.703(e) – interference proceedings

Not applicable. (0 days)

(vi) Delay Pursuant to 37 C.F.R. § 1.703(d) – secrecy order

Not applicable. (0 days)

(vii) Delay Pursuant to 37 C.F.R. § 1.703(e) – decision by BPAI or Federal court

Not applicable. (0 days)

(viii) Total Examination Delay Pursuant to 37 C.F.R. §1.703(f)

As set forth in 37 C.F.R. §1.703(f), the term of a patent entitled to adjustment under § 1.702 and § 1.703 shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of § 1.703, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704 (see section V, below for calculation).

The time period for the “Four Month Delay” cited in section III.B.(ii). above (237 days) is within the time period for calculating the “Three Year Delay” (763 days) and therefore, 237 days must be subtracted from the overall PTA calculation.

Therefore, the minimum total examination delay is the sum of the period of the 14 Month Delay (541 days) + Four Month Delay (237 days) + the Three Years Delay (763 days) – Overlap (237 days) - Applicants’ Delay (263 days) = **1041 days**

IV. Statement that patent will not be subject to terminal disclaimer (37 C.F.R. § 1.705(b)(2)(iii))

In accordance with 37 C.F.R. § 1.705(b)(2)(iii), the applicants submit that the pending patent corresponding to this application will not be subject to a terminal disclaimer.

V. Statement regarding reasonable efforts to conclude processing or examination of application as set forth in 37 C.F.R. § 1.704 (37 C.F.R. § 1.705(b)(2)(iv))

In accordance with 37 C.F.R. § 1.705(b)(2)(iv), the applicants submit that there were two circumstances which resulted in applicant delays according to 37 C.F.R. § 1.704(b) which are cited in the table below:

Action	Date action was filed	Due date of action for patent term adjustment purposes	Delay in days
Response after Non-Final Action	6 July 2009	2 May 2009	64
Response after Non-Final Action	23 November 2009	6 July 2009	140
Notice of Appeal	15 April 2011	15 February 2011	59
Total			263

With the exception of these delays, the applicants otherwise engage in reasonable efforts to conclude processing or examination of the application.

VI. Conclusion and Signature Block

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a minimum patent term adjustment of 1041 days.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

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Attachment: Patent Term Adjustments from PAIR

10/596,202	FORM OF ADMINISTRATION BASED ON CROSSLINKED HYDROPHILIC POLYMERS	512100-2056	01-05- 2012::14:32:02
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/596,202

Filing or 371(c) Date:	06-02-2006	Overlapping Days Between {A and B} or {A and C}:	0
Issue Date of Patent:	-	Non-Overlapping USPTO Delays:	778
A Delays:	778	PTO Manual Adjustments:	0
B Delays:	0	Applicant Delays:	263
C Delays:	0	Total PTA Adjustments:	515
Patent Term Adjustment History		Explanation Of Calculations	

Number	Date	Contents Description	PTO (Days)	APPL (Days)	Start
47	10-06-2011	Mail Notice of Allowance			30
46	10-04-2011	Office Action Review			0
45	10-04-2011	Office Action Review			0
44	10-04-2011	Office Action Review			0
43	10-04-2011	Office Action Review			0
42	10-04-2011	Issue Revision Completed			0
41	10-04-2011	Document Verification			0
40	10-04-2011	Notice of Allowance Data Verification Completed			0
39	09-19-2011	Interview Summary - Examiner Initiated			0
38	10-03-2011	Reasons for Allowance			0
37	10-03-2011	Examiner's Amendment Communication			0
36	10-03-2011	Allowability Notice			0
33	07-13-2011	Date Forwarded to Examiner			0
32	06-15-2011	Appeal Brief Filed			0
31	06-27-2011	Appeal Brief Review Complete			0
30	04-15-2011	Notice of Appeal Filed		59	24
29	04-15-2011	Request for Extension of Time - Granted			0
28	01-31-2011	Mail Advisory Action (PTOL - 303)			0

27	01-28-2011	Advisory Action (PTOL-303)		0
26	01-17-2011	Date Forwarded to Examiner		0
25	01-14-2011	Amendment after Final Rejection		0
24	11-15-2010	Mail Final Rejection (PTOL - 326)	237	19
23	10-01-2010	Final Rejection		0
21	08-18-2010	Case Docketed to Examiner in GAU		0
20	07-19-2010	Date Forwarded to Examiner		0
19	11-23-2009	Response after Non-Final Action	140	16
18	11-05-2009	Mail Notice of Informal or Non-Responsive Amendment		0
17	09-03-2009	Date Forwarded to Examiner		0
16.1	07-06-2009	Informal or Non-Responsive Amendment after Examiner Action		0
16	07-06-2009	Response after Non-Final Action	64	14
15	07-06-2009	Request for Extension of Time - Granted		0
14	02-03-2009	Mail Non-Final Rejection	541	6
13	02-02-2009	Non-Final Rejection		0
11	11-20-2008	PG-Pub Issue Notification		0
9	09-22-2008	Case Docketed to Examiner in GAU		0
8	08-27-2008	Case Docketed to Examiner in GAU		0
7	08-26-2008	Application Dispatched from OIPE		0
6	06-12-2006	371 Completion Date		0
5	08-11-2008	Sent to Classification Contractor		0
4	08-11-2008	Filing Receipt		0
3	08-11-2008	Notice of DO/EO Acceptance Mailed		0
0.5	12-13-2004	International Filing date		0